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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,478

Applicant(s)

TRENZ, THOMAS

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 and 19-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed 2/2/2005, to the original application filed 3/7/2001, claiming foreign priority date of 8/30/2000. IDS filed 5/21/2001.
2. The rejection of claims 9-25 under 35 U.S.C. 101 as being directed to non-statutory subject matter has been withdrawn as necessitated by amendment.
3. Claims 1-17, 19-26 pending. Claim 18 has been canceled. Claim 26 has been added. Claims 1, 9, 17, 26 are independent claims. Please note additional pages added to the Word 2000 reference.

Claim Rejections - 35 USC § 101

4. **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **The claimed invention as claimed in claim 26, is directed to non-statutory subject matter.**

In regard to independent claim 26, claim 26 recites “*A signal propagated over a computer network,...*”. It is respectfully noted that a signal carrying instructions for carrying out a method is non-statutory as not being tangibly embodied in a manner so as to be executable for its intended purpose, and is non-statutory for failing to be in one of the categories of invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-2, 5, 7-10, 13, 15-17, 19, 22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word 2000 (hereinafter Word 2000), Microsoft Corporation, application screenshots pp. 1-21, said application released on June 7, 1999, as evidenced by InternetNews article, <<http://internetnews.com/dev-news/article.php/132471>>, pages 1-3, downloaded on October 31, 3004.**

In regard to independent claim 1, Word 2000 teaches presentation of a one page printable document, said document including an inserted image (Word 2000 pages 13-15). Word 2000 also teaches user selectable sliding margin scales for expanding said one page document to cover two sheets (Word 2000 pages 15-16). Although Word 2000 does not specifically disclose said margin scale as a “print scale”, nevertheless, it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret this as such, because of the direct influence margin adjustment has over user adjustment of print font scaling to fit document data accordingly, providing the benefit of increased customization over the document layout process (compare with claim 1 “*A method performed by a computer system to print a document page... comprising*”).

Word 2000 teaches a “Print Preview” feature, which displays a document, said document displayed in a single dialog box showing how said pages will look when printed, sheet splitting, as well as a “Shrink to Fit” button (control element) for modifying the print scale (Word 2000 pages 14-17) (compare with claim 1 “*simultaneously displaying on a computer display, in one and the4 same dialog box, ...document page may be printed;*”).

Word 2000 teaches a user modifying the print scale via “Shrink to Fit” button, said application of said button causes the document to condense from two pages into a single page, within the same dialog (Preview) box (Word 2000 page 18) (compare with claim 1 “*enabling a user to modify the print scale....to increase or decrease;*”).

Word 2000 teaches dynamically changing the print scale, as explained above. The font scale of the document is shrunk accordingly, relative to the displayed sheet size. When the change is made, the print scale shrinks, therefore changing the sheet splitting since the second page is not needed and disappears (Word 2000 page 18) (compare with claim 1 “*dynamically changing the displayed print scale....modification of the print scale;*”).

Word 2000 teaches a print feature for printing pages of a document as it appears in “Preview” mode (Word 2000 pages 19-21). Pages 19-20 show the original document as spanning two sheets. Page 21 shows the resulting printed document (single sheet) after the font scale has been shrunk accordingly with new sheet splitting (it is noted that successive “Shrink to Fit” operations applied upon a multiple page document result in incremental rearrangement/modification of sheet splitting accordingly) (compare with claim 1 “*printing the document page....displayed sheet splitting upon receiving a print command.*”).

In regard to dependent claim 2, Word 2000 teaches “Print Layout” and “Print Preview” embodiments, implemented by the Word 2000 application (Word 2000 pages 1-21).

In regard to dependent claim 5, Word 2000 also teaches user selectable sliding margin scales for expanding said one page document to cover two sheets (Word 2000 pages 15-16). Although Word 2000 does not specifically disclose said margin scale as a “print scale”, nevertheless, it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret this as such, because of the direct influence

margin adjustment has over user adjustment of print font scaling to fit document data accordingly, providing the benefit of increased customization over the document layout process.

In regard to dependent claim 7, Word 2000 teaches a feature to display/print page numbering accordingly (the examiner has traced the pre-existing page numbers for clarity) (Word 2000 page 4, 16-18). The page numbers locate each sheet/page within a document, and are dynamically changed.

In regard to dependent claim 8, Word 2000 teaches shifting of sheet splits relative to the original page (letter vs legal) (Word 2000 pages 4, 6). In addition, Word 2000 teaches mouse controlled margin adjustment (Word 2000 page 16) which accordingly has a direct bearing on sheet splitting.

In regard to claims 9, 10, 13, 15, 16, claims 9, 10, 13, 15, 16 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 1, 2, 5, 7, 8 respectively, and are rejected along the same rationale.

In regard to claims 17, 19, 22, 24, 25, claims 17, 19, 22, 24, 25 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 1, 2, 5, 7, 8 respectively, and are rejected along the same rationale.

In regard to independent claim 26, claim 26 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

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8. **Claims 3-4, 11-12, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Word 2000, as applied to claims 1, 9, 17 above, and further in view of Goodman et al. (hereinafter Goodman), U.S. Patent No. 6,757,071, filed November 9, 1999, issued June 29, 2004.**

In regard to dependent claim 3, Word 2000 does not specifically teach the methods of the claimed invention implemented by a printer driver. However, Goodman teaches an intelligent printer driver for generating documents, whereby said driver comprises a print pre-viewer for displaying document (Goodman column 9 lines 13-17), and a recommendation module for automatically re-sizing a document (Goodman column 9 lines 32-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goodman's intelligent printer driver to Word 2000's processes as explained above, providing Word 2000 the benefit of decreasing the workload on Word 2000's own resources, and for interfacing with various printers.

In regard to dependent claim 4, Word 2000 teaches a print job whereby a user can select a larger or smaller size paper accordingly, as well as utilizing Page Layout controls accordingly (Word 2000 pages 4, 11). Said disclosure can be applied to Word 2000 "Print Preview" accordingly.

In regard to dependent claims 11, 12, claims 11, 12 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 3, 4 respectively, and are rejected along the same rationale.

In regard to dependent claims 20, 21, claims 20, 21 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 3, 4 respectively, and are rejected along the same rationale.

9. **Claims 6, 14, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Word 2000, as applied to claims 1, 9, 17 above, and further in view of Ilsar, U.S. Patent No. 6,694,487, filed December 10, 1998, issued February 17, 2004.**

In regard to dependent claim 6, Word 2000 does not specifically teach overlaying a preview with a grid. However, Ilsar teaches a page preview comprising a resizing grid, said grid overlain upon a document, said grid used for resizing purposes (Ilsar Abstract – especially at middle, also column 5 lines 41-50, column 6 lines 35-46, column 10 lines 15-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ilsar to Word 2000, providing print previewing which is easily tailorable (Ilsar column 2 lines 30-35). It is noted that Ilsar's invention can be integrated into various applications, such as Word 97 (see Ilsar column 7 lines 52-67).

In regard to dependent claim 14, claim 14 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 6, and is rejected along the same rationale.

In regard to dependent claim 23, claim 23 reflects the computer program product comprising computer readable instructions used for implementing the methods as claimed in claim 6, and is rejected along the same rationale.

Response to Arguments

10. Applicant's arguments filed 2/2/2005 have been fully and carefully considered but they are not persuasive.

It is respectfully noted that Applicant's amendment to the independent claims significantly changes the scope of the claimed invention when interpreted as a whole.

Applicant argues on page 9 of the amendment that Word 2000 does not teach changing print scales, etc. The examiner has now shown that Word 2000's "Print Preview" and especially "Shrink to Fit" buttons shrink the font (print scale) accordingly (in the same dialog box). It is noted that the claims do not force scaling of images within a document.

Applicant's arguments on pages 10-14 are similar to those presented above.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM BASHORE
PRIMARY EXAMINER

May 23, 2005